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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,544

10/17/2006

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010200-122

7115

21836 7590 10/28/2008
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EXAMINER

PERREAULT, ANDREW D

ART UNIT

PAPER NUMBER

3728

MAIL DATE

DELIVERY MODE

10/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/598,544	Applicant(s) MELROSE, DAVID MURRAY	
	Examiner ANDREW PERREAULT	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/3/06, 5/27/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to the preliminary amendment filed on May 27, 2007. As directed by the amendment: claims 5, 6, 9, 16-18, and 20 have been amended and claim 22 has been cancelled. Thus, claims 1-21 are presently pending in this application.

Oath/Declaration

2. The Office is hereby *sua sponte* waiving the express language requirement of 37 CFR 1.63(b)(3), where the oath or declaration was filed prior to 01 June 2008. The express language of 37 CFR 1.63(b)(3) is waived only to the extent necessary such that an oath or declaration containing the “material to examination” or “in accordance with § 1.56(a)” language, or both, will be accepted as acknowledging the applicant’s duty to disclose information “material to patentability” as defined in 37 CFR 1.56. Applicants are advised that, notwithstanding the preceding waiver, an applicant who has not disclosed information that is material to patentability as defined in 37 CFR 1.56, because it was believed that the information was not “material to the examination,” should disclose such information in order to discharge the applicant’s duty of disclosure as required by 37 CFR 1.56, and should file a supplemental oath or declaration acknowledging that duty of disclosure.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Container with an expandable seal.

4. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Drawings

5. The drawings have been received on September 3, 2006 and these drawings have been objected to under 37 CFR 1.84 for the following reasons: lines, numbers and letters are not uniformly thick and well defined; and numbers and reference characters are not plain and legible for all figures.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, line 3, "heated or heatable liquid" defines an indefinite range within a range. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation "heatable liquid", and the claim also recites "heated...liquid" which is the narrower statement of the range/limitation. In line 4, "said seal" lacks true antecedent basis, and is indefinite and misleading, as the claimed container as claimed defines no seal and "said" should be limited to elements of the claimed invention only, not imaginary possible adjuncts as here. The phrase should be --the seal--. With respect to an imaginary seal being referred to as "said seal" as if it were actually defined as an

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element of the invention occurs in claims 9, line 2, claim 12, where the secondary seal is indicated as positively claimed, and claim 18, line 2.

Regarding claim 4, the preamble refers to only the seal, and accordingly such is a dependent claim that claims less than its parent claim, and is improper. Also, in line 2, "said expansion" lacks antecedent basis, as no "expansion" per se has been defined.

Regarding claims 4 and 16, the phrase "like" renders the claims indefinite because the claims include elements not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claim 6, "said movable seal" is inconsistent language to describe the heretofore "seal" previously described. Consistent terminology of the elements pertaining to the invention should be maintained.

Regarding claim 8, line 2, "the neck finish or cap thereof" lacks antecedent basis for "cap" as set forth.

Regarding claim 10, line 2, "positioned or positionable" is again an indefinite range within a range. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). In the present instance, claim 10 recites the broad recitation "a commodity is ...positionable", and the claim also recites "a commodity is positioned" which is the narrower statement of the range/limitation.

Regarding claim 11, “said commodity” lacks antecedent basis, as a commodity being positionable is not a commodity per se, which is set forth by “said commodity”. In line 2, “tablet or pill” is indefinitely alternative and should be --one of a tablet and a pill--.

Regarding claim 12, line 2, “an aperture or port” is alternative and should be --one of an aperture and port--. See also claims 13 and 14.

Regarding claim 15, the alternative “or” phrase is again indefinite and should be --one of nitrogen and an oxygen-scavenging agent--. This would also appear to be a range within a range, as “nitrogen” is a narrower statement, whereas “oxygen-scavenging agent” is a broader statement, as apparently nitrogen may be characterized as an oxygen-scavenging agent.

Regarding claim 16, the term “balloon-like” is rendered further indefinite by being in quotations, these should be deleted. Quotations render claim language indefinite and should generally not be employed in claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-10 and 12-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Boyd (6,688,081).

Re claim 1, Boyd discloses a container (26; fig 2, 4-6) having an upper portion (12) with an opening (16) into said container, said upper portion having a neck finish adapted to include an expandable seal (52; fig 5) following the introduction of a heated liquid (col. 5, line 24-39) into the container, said seal being capable of movement (col. 7, line 29-61) within the neck finish to compensate for vacuum forces during cooling of the liquid following sealing of the container (col. 1, line 55-62; see col. 6, line 4-16 for cooling). Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Additionally, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re the dependent claims, while all such claimed and unclaimed elements may be anticipated by Boyd, this serves only to clearly show the capability of the claimed structure to functionally relate to the extraneous structure referred to as "adapted to"

Re claim 2, Boyd discloses wherein a surface (56; fig 5) of said seal extends transversely across the neck finish and is adapted to move further into the neck finish as the seal expands (col. 7, line 29-61). Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 3, Boyd discloses wherein said seal is of a flexible material having an expandable side wall (“headspace-displacing member 56”, col. 7, line 27-31 and “compliant gasket material”, col. 7, line 53-55; fig 5). Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Re claim 4, as best understood, Boyd discloses said side wall has a concertina construction (portion engaging with the threads 14 in fig 5) providing for said expansion.

Re claim 5, Boyd discloses in which the seal includes a rim portion (portion that engages 14 in fig 5) which can engage with a rim (14) of the neck finish.

Re claim 6, Boyd discloses in which said movable seal includes a side wall (“headspace-displacing member 56”, col. 7, line 27-31 and “compliant gasket material”, col. 7, line 53-55; fig 5) which can be physically moved relative to the neck finish and towards the liquid in the container. Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 7, Boyd discloses in which the side wall includes a screw thread (portion that engages 14 in fig 5) engageable with another screw thread (14) provided for said neck finish or a cap thereof.

Re claim 8, Boyd discloses in which the side wall provides a push-fit (col. 7, line 27-31) with the neck finish thereof.

Re claim 9, Boyd discloses wherein said seal provides a primary seal (56) for the container, a secondary seal (top portion of 54 as seen in fig 5) being provided for said neck finish over said opening into said container to define a secondary headspace (57 "hollow space"; fig 5) between the primary and secondary seals.

Re claim 10, Boyd discloses in which a commodity (58 "agent", fig 5) is positioned within said secondary headspace.

Re claim 11, Boyd discloses in which said commodity is a tablet intended for mixing with the liquid before use because the structure as much as claimed could so function.

Re claim 12, Boyd discloses in which said secondary seal includes an aperture (50 "clearance", fig 5; col. 7, line 38-55) to provide access into said secondary headspace (primary seal 56 can be a "relatively thin membrane" that allows for permeation col. 7, line 4-14). Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 13, Boyd discloses in which said aperture allows ingress of outside air into said secondary headspace (col. 7, line 38-55; col. 7, line 4-14) and is adapted to be closed off following sufficient cooling of the liquid. Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 14, Boyd discloses in which said aperture or port enables the entry into the secondary headspace of a commodity (col. 7, line 38-55; col. 7, line 4-14; col. 7, line 56-61). Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re claim 15, Boyd discloses in which the commodity is an oxygen-scavenging agent (col. 7, line 56-61).

Re claim 16, Boyd discloses in which the seal is of a flexible structure ("headspace-displacing member 56", col. 7, line 27-31 and "compliant gasket material", col. 7, line 53-55; fig 5) which is able to expand within the neck finish in compensating for vacuum pressure as the liquid cools (col. 1, line 55-62; see col. 6, line 4-16 for cooling).

Re claim 17, Boyd discloses a base (20; fig 2) which is adapted to be inverted to provide a compression of the seal to move it within the neck finish towards the said opening and to pressurize a secondary headspace above said seal. Furthermore, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 18, Boyd discloses in which said seal is in the form of a cap (fig 5) which is positionable about said opening, said cap being downwardly moveable to compress a headspace beneath the seal (col. 7, line 27-35).

Re claim 19, Boyd discloses in which a mechanical force provides for said downward movement (col. 7, line 27-35).

Re claim 20, Boyd discloses in which the cap is lockable in its downward position (col. 7, line 27-35).

Re claim 21, Boyd discloses a method of filling a container with a fluid which method includes introducing the fluid through an open end of the container so that it fills the container, heating the fluid before its introduction into the container, providing a moveable seal for the open end to cover and contain the fluid, said seal being capable of responding to the expansion or contraction of the fluid so as to compensate for pressure in a headspace of the container under the seal following sealing of the container (col. 5, line 40- col. 6, line 22).

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Gallagher (2,551,937) and Krishnakumar et al.(5,908,128).

Re claim 1, Gallagher and Krishnakumar disclose a container (respectively fig 1; fig 3) having an upper portion with an opening into said container, said upper portion having a neck finish adapted to include an expandable seal (5; 311 or 405) following the introduction of a heated liquid into the container, said seal being capable of movement within the neck finish to compensate for vacuum forces during cooling of the liquid following sealing of the container.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mollstam et al. (6,105,760) discloses a similar device (fig 7) with a commodity (col. 6, line 39-51) in which said commodity is a tablet (col. 6, line 48-49) intended for mixing with the liquid before use, for the purpose of forming carbonation or for medicinal use (col. 6, line 39-51).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW PERREAULT whose telephone number is (571)270-5427. The examiner can normally be reached on Monday - Friday, 8:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571)272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. P./

Examiner, Art Unit 3728

/Bryon P. Gehman/

Primary Examiner, Art Unit 3728